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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Reissue Application of:

BILL L. DAVIS and JESSE S. WILLIAMSON

For Reissue of U. S. Patent 5,630,363 § Group Art Unit: 2854

Issued May 20, 1997  
Serial No. 08/515,097

Filing Date: May 20, 1999.

RECEIVED

§ Examiner: \_\_\_\_\_

Serial No.: 09/315,796

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**FIRST SUPPLEMENTAL INFORMATION DISCLOSURE STATEMENT**

TO: The Assistant Commissioner of Patents  
Washington, D.C. 20231

Further to reissue applicants' initial disclosure statement and Tabs 1 and 2 thereto (U.S. Pats. 5,651,316 and 5,598,777 to DeMoore, not prior art), the file histories of those patents reveal that DeMoore filed what is believed to be four identical, or nearly identical specifications on October 2, 1995, as is indicated in Paper No. 7 on page two in Serial No. 08/538,123 (leading to the '316 patent):

Serial No. 08/538,123 filed October 2, 1995 (method);

Serial No. 08/538,021 filed October 2, 1995 (apparatus), presumed to be still pending;

Serial No. 08/538,274 filed October 2, 1995 (apparatus) leading to the '777 patent;

and

Serial No. 08/538,422 filed October 2, 1995 (apparatus), presumed to be still pending.

A search for counterparts in foreign countries reveals European and Japanese counterpart applications to the '777 and '316 patents (the 08/538,274 and 08/538,123 series, respectively) and to the 08/538,422 series. Information concerning prior art, as known, cited in these three

series is provided in Appendices II, III, and IV, including the file histories as known to date and the accompanying search reports.

No foreign counterparts were located which correspond to U. S. Serial No. 08/538,021, and applicants are unaware of any published U. S. patent based on said application.

A fourth series of pending applications exists by DeMoore, based upon a United States priority application, U. S. Serial No. 08/435,798 filed May 4, 1995. No granted U. S. patent is known to reissue applicants based on this application, and it is not even known at this time whether this application and any continuations are pending or abandoned. Counterparts to this application have been published in Canada, Japan, and the European Patent Office – EP 741 025 A3 – attached in Appendix I to this Supplemental Information Statement as Tab 1. This document was known to reissue applicants only recently, and was first published in Europe apparently in 1996. The application is viewed by reissue applicants as disclosing only part of reissue applicants' invention, and additionally, not claiming it. Reissue applicants further believe that the specification of EP 741 025 A3 is nonenabling as to reissue applicants' claimed invention.

Within Appendix I also exists the prior art cited in the European Patent Office to EP 741 025 (Tabs 2 - 8), the Canadian file history where no prior art was cited (Tab 9), the Japanese file history (Tab 12) where Japanese patent application Kokai 63-62733 was cited (Tab 10), corresponding to U. S. Patent 4,882,991 (Tab 11).

In Japan, the application was filed using the "English filing system," that is, the applicant DeMoore first filed English claims and a specification, and thereafter filed a Japanese translation thereof. An office action with a rejection was transmitted on June 30, 1998, in which the examiner pointed out some unsuitable descriptions in the claims. Original claim 1 included in Japan the following description: "an applicator head for applying ink or coating material to a plate mounted on the plate cylinder or to a blanket mounted on the blanket cylinder, either separately or simultaneously." (emphasis supplied). The examiner stated that an embodiment

for "apply ink or coating material simultaneously" was not disclosed in the specification. A second unsuitable description the examiner pointed out pertained to a translation error.

In reply to this action in Japan, DeMoore amended the above description in Claim 1 to read "an applicator head for applying ink or coating material to a plate mounted on the plate cylinder and to a blanket mounted on the blanket mounted on the blanket cylinder, selectively . . .," and corrected the translation error. (emphasis supplied). The application was allowed. The examiner did not believe that KOKAI 63-62733 was of such importance as to reject claims based on it.

Appendices II - III pertain to information known about three DeMoore applications with the same specification filed on October 2, 1995. In Appendix II information is brought forth concerning prior art cited in the '777 patent (Tab 13 is the '777 patent and Tabs 14 - 15 pertain to the two patents cited therein; Tab 16 is the counterpart European patent EP 767 057 A3 with its search report, and Tabs 17 - 20 pertain to the prior art cited in the European examination. The Japanese counterpart history shows that it is "sleeping," i.e., that examination has not yet taken place. (Tab 21).

Appendix III pertains to the '316 patent (Tab 22) series: Tabs 23 - 55 comprise prior art patents cited in the '316 file history; Tab 56 comprises the counterpart European patent EP 767,054 A3 and its search report; Tabs 57 - 58 comprise two patents cited in the European file history, and Tab 59 comprises the "sleeping" Japanese file history to date.

Appendix IV pertains to Serial No. 08/523,423 foreign counterparts; Tab 60 comprises EP 767 058 A3 and its search report; Tabs 61 - 63 comprise the prior art cited in the European file history, and Tab 64 is the still "sleeping" Japanese file history.

Reissue applicants contend U. S. Serial No. 08/435,798 and its European counterpart are not prior art to the '363 patent. Reissue applicants contend that the specification of U. S. Serial No. 08/435,798 is non-enabling as to reissue applicants' claimed invention. Whatever elements of reissue applicants' claimed invention, which are enabling in Serial No. 08/435,798, if any, reissue applicants contend were derived by DeMoore from reissue applicants. Reissue applicants

contend that DeMoore's October 2, 1995, priority inventions clearly are directed to a different invention(s) than the '363, and that Serial No. 08/435,798 clearly demonstrates that DeMoore did not at the time of filing intend to claim reissue applicants' invention, and was not in possession of that invention, as it did not provide, in reissue applicants' view, an enabling specification as to reissue applicants' claimed invention. Moreover, DeMoore never timely copied claims of the '363 patent to try to provoke an interference.

Appendices 5, 6, 7, and 8 contain the file histories of EP 741,025 A 3 (Tab 1), 767,057 A3 (Tab 16), 767,054 A3 (Tab 56) and 767,058 A3 (Tab 60). On October 6, 1998, the Examiner in the EP 741,025 prosecution made the following anticipation rejection over *Sliker, et al.* (Tab 3), U. S. Patent 5,107,790, not of record in the '363 prosecution:

1.1 Claim 1 in its present form can be read over US-A-5 107 790 (see col. 3, lines 41-42, col. 5, lines 35-47, Fig. 1) lacking therefore novelty (Art. 54 (1) (2) EPC). It is clear from the description on pages 2 and 3 that the following features, not comprised in claim 1 in its present form, are essential to the performance of the invention:

(1) "...the carriage assembly comprising a support arm having a first end portion constructed for pivotal attachment to the printing unit and a second end portion pivotally coupled to the applicator head, the applicator head being movable on the support arm between an operative position laterally adjacent to the plate and blanket cylinders and an elevated, retracted position in which the applicator head is elevated with respect to said plate and blanket cylinders..",

(2) "...a doctor blade assembly having a reservoir for receiving ink or liquid coating material..." and

(3) "...an applicator roller coupled to the doctor blade assembly in fluid communication with the reservoir, the applicator roller being engageable with a printing plate on the plate cylinder or with a blanket on the blanket cylinder when the applicator head is in the operative position.

Since independent claim 1 does not contain these features it does not meet the requirement following from Article 84 taken in combination with Rules 29(1) and (3) EPC that any independent claim must contain all the technical features essential to the invention.

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In order to overcome the abovementioned objections a new claim 1 should therefore be filed, said claim containing the abovementioned features (1)-(3).

- 1.2 The same objections raised on point 1.1 apply also to the subject-matter of independent claim 15.
3. To meet the requirements of Rule 27(1)(b) EPC, the document US-A-5 107 790 should be identified in the description and the relevant background art disclosed therein should be briefly discussed.

Applicant DeMoore replied to the European examiner on April 16, 1999, stating *inter alia* the following:

Claim 1 has been amended to distinguish it further from US 5,107,790 and, having regard to the Examiner's comments, to include a reference to the supply system for the ink or coating to be applied. However, we cannot agree with the Examiner that the disclosure in the specification requires that the claims should refer to those additional features set out in his comments. In particular, we dispute that the description on original pages 2 and 3 supports his contention.

In any case, it is necessary to look at the disclosure as a whole and it is clear that the claim as now amended has ample support in the application as filed. Specifically, the reference now in claim 1 to the ink or coating supply is sufficient for compliance with the requirements for support. It is not justifiable to require the applicant to limit his claim by including arbitrary elements of a preferred embodiment.

With regard to claim 15, it should be noted that this is not an independent claim as it refers to the inking/coating apparatus of the preceding claims. It thus imports all the features of claim 1 and requires no further particularisation.

The examiner has requested to pay particular attention to U. S. Patent 5,107,790 in view of the aforesaid Office Action.

Respectfully submitted,

  
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CERTIFICATE OF SERVICE

This is to certify that the foregoing First Supplemental Information Disclosure Statement was served on Plaintiffs' counsel of record by placing a true and correct copy in the United States Mail, postage prepaid, on the 16<sup>th</sup> day of July, 1999, addressed as follows:

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